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LUDWIG, MATTHEW J				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,121

Applicant(s)

LAVOIE ET AL.

Examiner

MATTHEW J. LUDWIG

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the Amendment received 2/19/08.
2. Claims 1-69 are pending in the application. Claims 1, 39, 58, 60, 68, and 69 are independent claims. Applicant added new claims 68 and 69.
3. Claims 1-67 rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen have been withdrawn pursuant to applicant's argument.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(c) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. **Claims 1-69 are rejected under 35 U.S.C. 102(e) as being anticipated by Spielberg, PG Pub. US 2002/0129057 filed (3/9/2001).**

In reference to independent claim 1 and 39, Spielberg teaches:

'a storage medium comprising security disclosure data in an audio format'. See page 3, [0022 through 0023]. The reference provides a memory means for storing audio formatted data and playing the audio formatted data to a user. Also the document file and the annotations files may comprise text, sound, and/or any other type of data.

'a processor for receiving the audio security disclosure data at a first time and for inserting a first marker therein'. See page 7, [0065 through 0070]. After playback of the document and recording of user comments are complete, annotator stores the associations information into memory. Each comment is typically associated with a certain document and/or a certain user. This suggests the inclusion of a marker to represent a specific user and/or document.

'said processor for creating a text directly from the audio security disclosure data at a second time subsequent to the first time and for inserting a second marker in the text in a position corresponding to a location of the first marker in the audio security disclosure data'. See page 6, [0061]. The reference provides a start mark and an end annotation directly from the audio formatted data.

In reference to dependent claim 2, Spielberg teaches:

Each comment the user provides is stored by the system in memory and associated with a location in the document that is contextually relevant to the comment. If, for instance, the document is a script, the person reviewing the script may insert comments about a particular scene. See page 5, [0044 and 0045].

In reference to dependent claim 3, Spielberg teaches:

PC or PDA may be components in communication with a processor for delivering content including said markers to a specific user. See page 4, [0042].

In reference to dependent claim 4 and 5, Spielberg teaches:

Each annotation file comprises one or more users. In one embodiment of the invention, the annotations (annotations that contain a first mark and an end mark) file contains a list of memory locations, network addresses, or *hyperlinks* that reference or comprise user comments. If the hyperlinks were presented using the interface of Spielberg it would allow the user to view the comments made to corresponding to specific content. See page 8, [0071 through 0072]. Furthermore, different users are tracked based upon annotations made. This would allow the user to review comments (annotations) made and select specific marker text using hyperlinks associated with the annotated data. See page 10, [0098] and page 11, [0099].

In reference to dependent claim 6, Spielberg teaches:

If a user named user 1 made comments about a particular portion of a document, the device would identify, at the time the comment was played, that the comment originated from user 1. See page 5, [0047].

In reference to dependent claim 7, Spielberg teaches:

A subsequent annotation mark may signify the end of user comments for that location in the document. In some instances the passage of a certain period of time causes the annotation end mark to occur. See page 6, [0061 and 0062].

In reference to dependent claim 8, Spielberg teaches:

As structured, a second user may comment on any comment in annotations file made by a previous user. Therefore, it is possible to have a series of comments at the same level serving as intermediate nodes to additional comments. Because any comment or mark would have a beginning mark and end mark, the reference suggests a means of providing a third comment (mark) corresponding to the first and second mark.

In reference to dependent claim 9, Spielberg teaches:

The use of a hierarchical tree in this form makes it possible to add comments upon comments to any desired level, limited only by the memory capacity of the server, while still maintaining the ability to trace back to the original document. With this tree structure, it is possible to traverse the hierarchical tree to review selective comments using an annotation engine. See page 11, [0099 through 0100]. The annotations file contains a list of memory locations, network addresses, or hyperlinks that reference or comprise user comments. See page 8, [0071].

In reference to dependent claims 10-22, the language reflects similar language found within claims 1-9. The reference to Spielberg teaches a hierarchy of comments made by specific users and allows for the retrieval and review of comments through a user interface. Therefore, claims 10-22 are rejected under similar rationale.

In reference to dependent claim 23, Spielberg teaches:

If a user named user 1 made comments about a particular portion of a document, the device would identify, at the time the comment was played, that the comment originated from user 1. See page 5, [0047].

In reference to dependent claim 24, Spielberg teaches:

A subsequent annotation mark may signify the end of user comments for that location in the document. In some instances the passage of a certain period of time causes the annotation end mark to occur. See page 6, [0061 and 0062].

In reference to claims 25-38, the language reflects similar language found within claims 1-9. The reference to Spielberg teaches a hierarchy of comments made by specific users and allows for the retrieval and review of comments through a user interface. Therefore, claims 10-22 are rejected under similar rationale.

In reference to dependent claim 40-57, the claims recite various descriptions of what a marker is based upon. The mark taught by Spielberg is a mark based upon an annotation which is based upon a comment which could be based upon a script. The reference provides a proficient suggestion of a mark that could be based upon many different types of data or content. Therefore, the reference suggests annotations made based upon a variety of concepts dependent upon the content being retrieved. See pages 5, [0045 through 0047] and page 6, [0061 through 0063].

In reference to independent claim 58, the claim recites similar language to the rejected apparatus claim, independent claim 1. Therefore, independent claim 58 is rejected under similar rationale.

In reference to dependent claim 59, Spielberg teaches:

At the occurrence of annotation start mark, audio playback of the document pauses and annotator begins recording user comments. See page 6, [0062].

In reference to independent claim 60, the claim recites similar language to the rejected apparatus claim, independent claim 1. Therefore, independent claim 58 is rejected under similar rationale.

In reference to dependent claim 61, Spielberg teaches:

Annotator has the capability to record sound and text data from a user. User comments may arrive from a sound input source such as a microphone and recorded in memory by annotator. See page 7, [0063].

In reference to dependent claim 62 and 63, Spielberg teaches:

Nodes may be added to the hierarchical tree of annotations. The use of a hierarchical tree in this form makes it possible to add comments upon comments to any desired level. With this tree structure, it is possible to traverse the hierarchical tree to review selective comments using a sophisticated playback controller and annotating engine. Also, the reference discloses monitors for use with the system to display graphical images. See page 11, [0099 through 0107].

In reference to claims 64-67, the reference to Spielberg teaches comments provided by the user and stored by the system in memory and associated with a location in the document that is contextually relevant to the comment. The example of a script is provided, however, the reference does not limit the content to script. It allows for varying types of content and data to be used with the system and does not limit the invention to a specific type of data. See page 5, [0045].

In reference to claims 68 and 69, the claims recite similar limitations to those found in Independent claim 1 and dependent claim dependent claim 62. Therefore, the claims are rejected under similar rationale.

Response to Arguments

6. Applicant's arguments with respect to claims 1-69 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. LUDWIG whose telephone number is (571)272-4127. The examiner can normally be reached on 9:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen S. Hong/
Supervisory Patent Examiner, Art Unit
2178

ML

